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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/581,614	06/15/2000	Kenneth Hoo-Yin Lam	36-1337	1019

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EXAMINER

ESCALANTE, OVIDIO

ART UNIT	PAPER NUMBER
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2645

DATE MAILED: 05/05/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/581,614

Applicant(s)

LAM, KENNETH HOO-YIN

Examiner

Ovidio Escalante

Art Unit

2645

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 June 2000.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on \_\_\_\_\_ is: a) ☐ approved b) ☐ disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) ☐ The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a) ☐ All b) ☐ Some \* c) ☐ None of:  
1. ☐ Certified copies of the priority documents have been received.  
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.  
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).  
\* See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

### Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☒ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 4.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). \_\_\_\_\_
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other:

### **DETAILED ACTION**

1. This action is in response to applicant's preliminary amendment filed on June 15, 2002.

**Claims 1-10** are now pending in the present application.

#### ***Information Disclosure Statement***

2. The information disclosure statement submitted on April 6, 2001 was received. The submission is in compliance with the provisions of 37 CFR 1.97. Accordingly the information disclosure statement is being considered by the examiner.

#### ***Specification***

3. The title of the invention is not descriptive. A new title is required that is clearly indicative of the invention to which the claims are directed.

#### ***Claim Objections***

4. Claim 9 is objected to because of the following informalities: in line 1 or 2, either the first or second use of the word "subsequent" should be deleted. Appropriate correction is required.

#### ***Claim Rejections - 35 USC § 102***

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

The changes made to 35 U.S.C. 102(e) by the American Inventors Protection Act of 1999 (AIPA) and the Intellectual Property and High Technology Technical Amendments Act of 2002

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do not apply when the reference is a U.S. patent resulting directly or indirectly from an international application filed before November 29, 2000. Therefore, the prior art date of the reference is determined under 35 U.S.C. 102(e) prior to the amendment by the AIPA (pre-AIPA 35 U.S.C. 102(e)).

6. Claims 1-5,8 and 10 are rejected under 35 U.S.C. 102(e) as being anticipated by Yacenda et al. US Patent 5,822,418.

*Regarding claim 1*, Yacenda teaches a telecommunications network including a network based telephone answering system to which calls for a particular network destination may be diverted, (col. 21, lines 7-19; each individual of the network, (customer) is able to setup a profile for using call screening and which may divert the call),

the network including control means programmable by customer action to select conditions under which some or all calls for the destination are diverted, (col. 21, lines 7-26; calling parties that are included in a call screening list will be diverted to a locator feature. Those calling parties that are not included will not be directed to the locator feature),

the telephone answering system further including means selectively to store respective messages and to associate such messages with a particular one of a plurality of customers of the destination in response to predetermined characteristics for an incoming call, (col. 17, lines 48-63; a calling party may leave a message for the customer if the customer was not located or is busy),

and means to selectively play messages only on receipt of signals identifying a particular customer, (col. 17, lines 48-64; col. 18, lines 25-32).

**Regarding claim 2**, Yacenda teaches the telephone answering system is responsive to receipt of a diverted call to cause information identifying each of said plurality of customers to be transmitted to a calling customer, (col. 15, lines 46-58; the calling party receives information about group members) said system connecting means responsive to calling customer action to associate a subsequently deposited message with a particular one of said plurality of customers, (col. 17, lines 53-64; once the calling party selects a particular customer and the customer is unavailable then the calling party can leave a message for the customer).

**Regarding claim 3**, Yacenda teaches the telephone answering system is responsive to network signals identifying the calling party to associate a message received during the same call with a particular one of the plurality of customers, (col. 19, lines 45-56; col. 21, lines 7-19).

**Regarding claim 4**, Yacenda teaches in which calls are selectively diverted to the telephone answering system or are connected to the network destination in dependence upon the network signals identifying the calling party line, (col. 21, lines 7-41; if the calling party is on a call screening list then they are connected to the customer; if the calling party is not on the list the they are routed to a telephone answering system).

**Regarding claim 5**, Yacenda teaches in which calls for at least one of the plurality of customers of the network destination are required to be diverted to the telephone answering system while calls for at least one other of the plurality of customers are to be connected to the particular network destination the network being responsive to calls for the particular network destination to provide information to the calling party line identifying each of the plurality of customers and responding to customer reaction thereto to connect the call either to the network destination or to the telephone answering system, (col. 15, lines 46-48; col. 21, lines 7-26; since

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each customer may setup their own profile, then calls to one specific customer may all be diverted whereas calls to another customer may be connected to the customer).

**Regarding claim 8**, Yacenda teaches in which the telephone answering system is responsive to signaling identifying a particular one of the plurality of customers to play back respective messages stored for that customer, (col. 8, lines 25-32).

**Regarding claim 10**, Yacenda teaches subsequent to playing messages for the identified one of the plurality of customers the system causes a voice announcement indicative of the presence or absence of messages for other users at the same network destination, (col. 21, lines 7-26; col. 15, lines 46-48; the system is able to announce messages for all customers that are part of the same group or are at the same location).

***Claim Rejections - 35 USC § 103***

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

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9. Claims 6,7 and 9 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yacenda in view of Matthews et al. US Patent 4,602,129.

***Regarding claims 6,7 and 9***, Yacenda, as applied above, does not specifically teach of having a stored message being associated with more than one of the plurality of customers.

Matthews teaches of a voice mail system which has a feature of a verbal bulletin board, (col. 70, lines 35-57). The verbal bulletin board of Matthews is capable of receiving a message from a calling party and is further capable of associating the message with more than one of the plurality of users if the calling party does not designate a single specific user, (col. 70, lines 35-57).

Matthews further teaches that when one of the user calls up the voice mail system they may be able to listen to all of their specific messages and further be able to listen to a message that was not associating with any particular user i.e. associated with all of the plurality of customers, (col. 70, lines 35-57)

Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify the system of Yacenda by allowing the calling party to leave a message for a group of customers that is not specifically for a single customer as taught by Matthews so that it will not be necessary to leave a message for each customer if the calling party wants to leave the same message for multiple customers.

### ***Conclusion***

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Blake et al. US Pub. 2001/0043679 teaches of a notice board type of voice mail system which is used to provide a calling party with general or specific announcements.

11. Any response to this action should be mailed to:

Commissioner of Patents and Trademarks  
Washington, D.C. 20231

or faxed to:

(703) 872-9314, (for formal communications intended for entry)

Or:

(703) 872-9314, (for informal or draft communications, please label  
"PROPOSED" or "DRAFT")

Hand-delivered responses should be brought to Crystal Park II, 2121 Crystal Drive, Arlington, VA, Sixth Floor (Receptionist).

12. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Ovidio Escalante whose telephone number is (703) 308-6262. The examiner can normally be reached on Monday to Friday from 6:30 AM to 5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Fan Tsang, can be reached on (703) 305-4895. The fax phone number for this Group is (703) 872-9314.

Communications via Internet e-mail regarding this application, other than those under 35 U.S.C. 132 or which otherwise require a signature, may be used by the applicant and should be addressed to [fan.tsang@uspto.gov].



All Internet e-mail communications will be made of record in the application file. PTO employees do not engage in Internet communications where there exists a possibility that sensitive information could be identified or exchanged unless the record includes a properly signed express waiver of the confidentiality requirements of 35 U.S.C. 122. This is more clearly set forth in the Interim Internet Usage Policy published in the Official Gazette of the Patent and Trademark on February 25, 1997 at 1195 OG 89.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Technology Center 2600 Customer Service Office whose telephone number is (703) 306-0377.

Ovidio Escalante  
Examiner  
Group 2645  
April 28, 2003

**FAN TSANG**  
**SUPERVISORY PATENT EXAMINER**  
**TECHNOLOGY CENTER 2600**

